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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,663	04/14/2004	Naoto Ohshima	Q80834	4957

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,663

Applicant(s)

OHSHIMA, NAOTO

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/401,893.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>14 April 2004</u> | 6) <input type="checkbox"/> Other: ____ |

This application is before the examiner for consideration on the merits.

A. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1-13, drawn to a photographic material, classified in class 430, subclass 567.

II. Claims 14-16, drawn to an image forming method, classified in class 430, subclass 363.

Inventions of Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the image forming method as claimed can be practiced with other materially different products such as those known in the art or commercially available photographic materials.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Mr. Bruce E. Kramer on 26 April 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-16 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. However, claims 14-16 are depended on the material claim 1. They are permitted to be rejoined with the material claim 1 when it is found to be allowable.

B. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,777,174 considered in view of Yamashita et al (5,573,903) and Aylward et al (6,465,164).

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The applied claims are related to a color photographic material comprising a support having thereon at least three yellow-, magenta- and cyan-dye forming layers and a non-photosensitive layer with up to 6 g/m^2 of gelatin and up to 0.5 g/m^2 of silver and the yellow-dye forming layer containing 90 mol% or more of silver chloride in the silver halide grains of 0.6 microns or less in a sphere-equivalent diameter.

The applied claims do not have the embodiments of (selenium and gold as silver halide sensitizing agent in claims 1 and 5) and (sulfur as silver halide sensitizing agent in claim 13). Yamashita et al at col.17:61 to 23:49 is cited to show the known use of selenium, gold and sulfur as the silver halide sensitizing agents.

Aylward et al do not specify green- and red-sensitive silver halide grains of 0.5 microns or less in a sphere-equivalent diameter as that in claim 5. However, Aylward disclose, teach, suggest and reduce to practice with blue-sensitive silver halide grains having 0.30 microns and red-sensitive silver halide grains having 0.40 microns in an edge length which are the same or about the same those as claimed. The language "sphere-equivalent diameter" is and considers as a physical property of a material. It is allowed to request and require applicants to show not the patentably different or overlapped-able but patentably distinct between all of the claimed silver halide grains over those of the applied silver halide grains on the record for the patentability of claim 2 in accordingly with the authority stated in *In re Schreiber*, 44 USPQ2d 1429. An argument alone may have and be given a little to no value. A showing should and must be provided before a final Office action is made in order for it to be considered timely.

Since the above references are all related to photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite

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the known use of selenium, gold and sulfur from Yamashita et al for a reasonable expectation of obtaining high sensitive silver halide photographic material as disclosed, taught, suggested and obtained in Yamashita et al and use or cited the same or about the same silver halide grains for a reasonable expectation of obtaining the same or about the same amount of silver halide grains in the green- and/or red-sensitive layer as disclosed, taught and suggested in Aylward et al.

C. The record shows that applicant, Fuji Photo and their counsel fail to comply with the statutory under 37 CFR 1.56 with respect to the closely related embodiments in claims 1-8 in Application No. 10/823,700.

Claims 1, 3 and 5-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of Application No. 10/823,700 considered in view of Yamashita et al (5,573,903).

The applied claims are related to a color photographic material comprising a support having thereon at least three yellow-, magenta- and cyan-dye forming layers and a non-photosensitive layer with up to 0.5 g/m^2 of silver and the yellow-dye forming layer containing 90 mol% or more of silver chloride in the silver halide grains of 0.6 microns or less in a sphere-equivalent diameter.

The applied claims do not have the embodiments of (selenium and gold as silver halide sensitizing agent in claims 1 and 5) and (sulfur as silver halide sensitizing agent in claim 13). Yamashita et al at col.17:61 to 23:49 is cited to show the known use of selenium, gold and sulfur as the silver halide sensitizing agents.

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Since the above references are all related to photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known use of selenium, gold and sulfur from Yamashita et al for a reasonable expectation of obtaining high sensitive silver halide photographic material as disclosed, taught, suggested and obtained in Yamashita et al.

D. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aylward et al (6,465,164) considered in view of Yamashita et al (5,573,903).

Aylward et al disclose, teach and suggest a color photographic material comprising a support having thereon at least three yellow-, magenta- and cyan-dye forming layers and a non-photosensitive layer with less than 0.5 g/m^2 of silver and the yellow-dye forming layer containing 90 mol% or more of silver chloride. The blue-sensitive silver halide grains are sensitized with sulfur and gold containing compound(s). Please see the whole disclosure of each of the applied references, especially in Aylward et al at col.46:8-22, 47:65 to 48:39, 53:51 to 54:50 and Table 6 on col.58:7 to 59:18.

Aylward et al do not specify blue-sensitive silver halide grains of 0.7 microns or less in a sphere-equivalent diameter as that in claim 1 and those of 0.5 microns in claim 5. However, Aylward disclose, teach, suggest and reduce to practice with blue-sensitive silver halide grains

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having 0.6 microns, green-sensitive silver halide grains having 0.30 microns and red-sensitive silver halide grains having 0.40 in an edge length which are the same or about the same those as claimed. The language "sphere-equivalent diameter" is and considers as a physical property of a material.

Aylward et al do not specify "selenium" as that in claim 1. Yamashita et al at col.17:61 to 22:60 is cited to show the known use of selenium as the silver halide sensitizing agents.

Since the above references are all related to silver halide photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the know use of selenium for a reasonable expectation of obtaining a high sensitive silver halide photographic material as disclosed, taught, suggested and obtained in Yamashita et al.

E. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
28 April 2005

HOA VAN LE
PRIMARY EXAMINER

A handwritten signature in black ink that reads "Hoa Van Le". The signature is written in a cursive style with a horizontal line extending from the left of the first letter.